

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/824,217

Applicant(s)

STEPHENSON ET AL.

Examiner

Michael J. Feely

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Michael J Feely/
Primary Examiner, Art Unit 1796

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant argues that the instantly claimed "particulate" does not encompass an agglomerate particle. Specifically, they argue:

- (1) that the multi-component particles (300) of Rickards are not disclosed as porous particles/particulates;
- (2) that the multi-component particles (300) of Rickards would not have met the instantly claimed ASG limitation;
- (3) that the Rickards reference does not disclose a "glazing" material; and
- (4) that the particulates of Rickards are not "proppants".

(1) Contrary to Applicant's assertion, an agglomerate is indeed a particle/particulate. It is essentially a compound particle/particulate made of sub-particles, wherein the agglomerate behaves and exists as a single particle/particulate. Accordingly, the term "particulate" embraces an agglomerated particle. Furthermore, Rickards explicitly discloses that these agglomerate particles, both treated and untreated, are porous in nature: "the deformable material (304) functions to at least PARTIALLY coat and/or fill PORE SPACES existing between individual non-deformable material components (302) as shown in FIG. 30" (see column 20, lines 45-48).

(2) Apparent specific gravity (or apparent density) is a gravity influenced packing density, wherein a material is gravity-fed into a specified volume. This mass per volume is reflective of more than just the type(s) of material(s) present. This measurement is influenced by a number of factors including: material type/density, average particle size, particle size distribution, particle shape, and particle porosity. In the instant case, the "porous particulate material" is represented by the untreated agglomerate in Rickards, and the "selectively configured porous particulate material" is represented by the treated agglomerate in Rickards (300). Although the deformable material of the treated agglomerate may be more dense than the empty pores of the untreated agglomerate, it appears that the deformable material would have had a significant impact on the packing ability of the material. This is especially the case where the optional outerlayer (304) is provided. While the pores of the untreated agglomerate are capable of being packed/compressed by the weight of additional agglomerates, the presence of the deformable material (at least partial coating/filling the pores) appears to hinder this packing ability. Accordingly, the untreated agglomerate appears to be capable of packing more non-deformable material within a specific volume than the treated agglomerate. This would lead to a higher ASG for the untreated agglomerate because the non-deformable material has a higher density than the deformable material.

(3) The term "glazing material" is a broad term that encompasses any material that is capable of forming a smooth coating on a material. The deformable materials disclosed in Rickards appear to be inherently capable of this function (see column 20, line 67 through column 21, line 15).

- (4) Rickards explicitly discloses that these materials are proppants (see column 21, lines 45-52).

Accordingly, the final rejection of the pending claims stands.